

REMARKS

Applicant requests favorable reconsideration of this application in view of the foregoing amendments and the following remarks. Claims 1-22 were pending in the application and were rejected in the Office Action. By way of this amendment, Applicant has amended claim 15 to eliminate a limitation and, therefore, broaden the scope of the claim. In addition, Applicant has presented new claims 23, 24 and 25.

Applicant appreciates the Examiner's thoughtful reconsideration and withdrawal of each of the previous rejections.

1. Rejection of Claim 15

The Examiner rejected claim 15 under 35 U.S.C. § 112, ¶ 2 as allegedly "being incomplete for omitting essential structural cooperative relationships of elements." Applicant respectfully submits that this rejection has been fully obviated by way of the amendments made herein to claim 15 and, therefore, Applicant earnestly solicits a withdrawal of the rejection of claim 15 under § 112, ¶ 2.

2. Rejections of Claims 1-14: Kerns

The Examiner rejected: (a) claims 1-8 and 10-13 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,305,801 ("Kerns"); and (b) claims 9 and 14 under 35 U.S.C. § 103(a) as allegedly being obvious in view of Kerns. For the following reasons, Applicant respectfully traverses these rejections.

Claim 1, which remains in its original format, recites "an optical *device*" that includes, among other possible things (*italic emphasis added*):

a light source emitting light along an illuminating beam having a two-dimensional cross-sectional area;

a main objective;

a spectral filter positioned between the light source and the main objective,

wherein the spectral filter is adapted to reduce, without eliminating, the intensity of the light emitted by the light source in a specific region, the specific region being a subsection of the two-dimensional cross-sectional area of the illuminating beam.

As hereafter explained, Kerns fails to teach or suggest such an optical device.

In rejecting claim 1, the Office Action admits that Kerns "does not expressly disclose a light source or a main objective." To support an argument that Kerns implicitly teaches a light source and a main objective, the Office Action states that "it is inherent for a contact

lens (or a spectral filter) to receive light with a two-dimensional cross-sectional area” and that the recitation of the main objective is satisfied by “the eye under the contact lens.” Applicant respectfully disagrees.

First, claim 1 does not recite an infinite universe from which elements (*e.g.*, sunlight) can be plucked at will. Rather, claim 1 recites “an optical device.” Accordingly, any reference to be applied as § 102 prior art must disclose *an optical device* that includes a light source and an objective. Kerns teaches an optical device in the form of a contact lens. Kerns’ optical device, which is a spectral filter, does not itself expressly or implicitly include either (a) a light source or (b) an objective. Rather, the optical device taught by Kerns is to be used with a second device (*i.e.*, the human eye); the combination of these two separate devices may then be exposed to sunlight from a third device (*i.e.*, the sun). Moreover, even assuming, *arguendo*, that a person wearing the contact lens on any eyeball is an optical device, such a device would still fail to teach or suggest each limitation of claim 1 as the device would still fail to teach a light source.

As Kerns fails to teach or suggest *an optical device* that itself includes each of the limitations of claim 1, Kerns standing alone can not be used to reject claim 1, or any claim dependent thereon, under 35 U.S.C. §§ 102(b), 103(a). Moreover, as claims 2-14 depend from claim 1, each of these dependent claims is also allowable over Kerns, without regard to the other patentable limitations recited therein. Accordingly, Applicant respectfully requests a withdrawal of the Kerns-based rejections of claims 1-8 and 9-13 under § 102(b) and claims 9 and 14 under § 103(a).

3. Rejection of Claims 1, 3, 14, and 16-22: Klopotek

The Examiner rejected:

(a) claims 1, 3, 21 and 22 under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 6,056,739 (“Klopotek”);

(b) claims 14 and 16 under 35 U.S.C. § 103(a) as allegedly being obvious when considering Klopotek in view of U.S. Patent No. 4,991,954 (“Akiyama”);

(c) claims 17-19 under 35 U.S.C. § 103(a) as allegedly being obvious when considering Klopotek in view of Akiyama and further in view of U.S. Patent No. 6,297,912 (“Goto”); and

(d) claim 20 under 35 U.S.C. § 103(a) as allegedly being obvious when considering Klopotek in view of U.S. Patent No. 6,271,968 (“Dobrowolski”).

For the following reasons, Applicant respectfully traverses these rejections.

a. Claims 1, 3, 21, and 22: Klopotek

Klopotek, like Kerns, fails to teach or suggest *an optical device* that itself includes, among other possible things, a light source, a main objective, and a spectral filter, as recited in claim 1. More specifically, although Klopotek teaches a light source (*i.e.*, laser 22), like Kerns, it completely fails to teach or suggest an objective. In addition, as later explained, Klopotek also fails to teach or suggest a spectral filter.

The Office Action asserts that Klopotek teaches an objective by citing to the human eye 14 shown in Figure 1. Applicant respectfully disagrees. As was the case with Kerns, whereas the eye 14 in Klopotek arguably is an optical device, it is not part of the optical device that includes the light source (*i.e.*, laser 22). Rather, the eye 14 is an entirely separate device. Rather, the optical device taught by Klopotek is to be used with a second device (*i.e.*, the human eye).

Even assuming, *arguendo*, that the eye and the device containing the light source (*i.e.*, laser 22) were considered one optical device, Klopotek would still fail to teach or suggest every limitation of claim 1. Specifically, although the Office Action analogizes the profiler 34 to the spectral filter recited in claim 1, Applicant respectfully disagrees. The profiler 34 divides the light emitted by the laser 22 into subbeams 38. *See* col. 6, lines 1-7. As a result of the division and the creation of the subbeams 38, Klopotek teaches a plurality of high-intensity light beams interspaced amongst two-dimensional areas in which no light beams are present. Accordingly, whereas claim 1 recites that “the spectral filter is adapted to reduce, *without eliminating*, the intensity of the light emitted by the light source in a specific region,” Klopotek teaches exactly the opposite by teaching the complete elimination of light in particular two-dimensional areas between the subbeams 38.

As Klopotek fails to teach or suggest *an optical device* that itself includes each of the limitations of claim 1, Klopotek standing alone can not be used to reject claim 1, or any claim dependent thereon, under 35 U.S.C. § 102(b). Moreover, as claims 3, 21, and 22 depend from claim 1, each of these dependent claims is also allowable over Klopotek, without regard to the other patentable limitations recited therein. Accordingly, Applicant respectfully requests a withdrawal of the Klopotek-based rejections of claims 1, 3, 21, and 22 under § 102(b).

b. Claim 14 and 16: Klopotek and Akiyama

As previously discussed, although Klopotek teaches an optical device that includes a light source, Klopotek's optical device includes neither an objective nor a spectral filter, as recited in claim 1. Akiyama fails to cure both of these deficiencies.

Akiyama teaches an objective in the form of human eye 11, as shown in Figure 2. The eye 11, however, is not part of the optical device that includes the laser light source 1. In addition, the filter 102c cited by the Examiner fails to satisfy the limitations of the spectral filter recited in claim 1. Specifically, as shown in Figures 13A and 13B, the entire two-dimensional area of the light (that is shown as traveling into the paper along axis 1a) is subject to the same filtering protocol. In other words, contrary to claim 1, which recites a region in which the light intensity is reduced being a "subsection of the two-dimensional cross-sectional area of the illuminating beam," Akiyama teaches that the entire two-dimensional cross-sectional area of the illuminating beam is subject to intensity reduction.

As the combination of Klopotek and Akiyama fails to teach or suggest *an optical device* that includes each of the limitations of claim 1, the combination can not be used to reject claim 1, or any claim dependent thereon, under 35 U.S.C. § 103(a). Moreover, as claims 14 and 16 depend from claim 1, each of these dependent claims is also allowable over the combination of Klopotek and Akiyama, without regard to the other patentable limitations recited therein. Accordingly, Applicant respectfully requests a withdrawal of the rejection of claims 14 and 16 under § 103(a).

c. Claims 17-19: Klopotek, Akiyama, and Goto

As previously discussed, the combination of Klopotek and Akiyama fails to teach or suggest each of the limitations of the optical device recited in claim 1. As hereafter explained in detail, Goto fails to cure this deficiency.

Although Goto teaches an objective optical system 54 (shown in Figure 12), Goto fails to teach or suggest a spectral filter that is "adapted to reduce, *without eliminating*, the intensity of the light emitted by the light source in a specific region." Rather, the low-pass phase filter taught in Goto is designed to eliminate completely high-frequency signals that may otherwise negatively impact an image. *See* col. 2, lines 1-11.

As the combination of Klopotek, Akiyama, and Goto fails to teach or suggest *an optical device* that includes each of the limitations of claim 1, the combination can not be used to reject claim 1, or any claim dependent thereon, under 35 U.S.C. § 103(a). Moreover, as claims 17-19 depend from claim 1, each of these dependent claims is also allowable over the combination of Klopotek, Akiyama, and Goto, without regard to the other patentable

limitations recited therein. Accordingly, Applicant respectfully requests a withdrawal of the rejection of claims 17-19 under § 103(a).

d. Claim 20: Klopotek and Dobrowolski

As previously discussed, Klopotek fails to teach or suggest each of the limitations of the optical device recited in claim 1. hereafter explained in detail, Dobrowolski fails to cure this deficiency.

Similar to Goto, Dobrowolski teaches a cut-off filter having “a sharp cut-off at a predetermined wavelength λ .” *See* col. 1, lines 53-55. In other words, Dobrowolski teaches completely eliminating certain wavelengths of light. In contrast, claim 1 specifically recites that the spectral filter be “adapted to reduce, *without eliminating*, the intensity of the light emitted by the light source in a specific region.” As a result, Dobrowolski fails to cure at least this deficiency of Klopotek.

As the combination of Klopotek and Dobrowolski fails to teach or suggest *an optical device* that includes each of the limitations of claim 1, the combination can not be used to reject claim 1, or any claim dependent thereon, under 35 U.S.C. § 103(a). Moreover, as claim 20 depends from claim 1, this dependent claim is also allowable over the combination of Klopotek and Dobrowolski, without regard to the other patentable limitations recited therein. Accordingly, Applicant respectfully requests a withdrawal of the rejection of claim 20 under § 103(a).

4. New Claims 23, 24 and 25

New claims 23 and 24, which were added as a result of the amendments made herein to claim 15, have been added to depend from dependent claim 15. Accordingly, without regard to the other patentable limitations recited in new claims 23 and 24, each of these claims is allowable for at least the same reasons as claim 15. New claim 25 recites a feature seen best by the up-and-down arrow shown in Figure 1 of the drawings, and as described in paragraph [0035] of the specification.

CONCLUSION

For the aforementioned reasons, claims 1-25 are now in condition for allowance. A Notice of Allowance at an early date is respectfully requested. The Examiner is invited to contact the undersigned if such communication would expedite the prosecution of the application.

Respectfully submitted,

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